

## REMARKS/ARGUMENTS

By this paper, Applicant replies to the Office Action of October 15, 2007 and respectfully requests careful consideration of the application.

Claims 13, 23, 25, 27, 32, 33, 37, 43, 50-53, and 55-77 are now pending. Claims 13, 23, 25 and 37 are independent.

### **I. Breadth is Not Indefiniteness; “Positively Recited” is Not a Legal Requirement**

The Office Action quotes the form paragraph for § 112 ¶ 2 but fails to raise any issue relating to any current legal standard under that provision. Instead, the Office Action confirms that the Examiner was reasonably able to come to an understanding of the “metes and bounds” of the claim, at least under a “broadest reasonable interpretation consistent with the specification” standard. If the claim can be construed, it is not indefinite. *Exxon Research and Engineering Co. v. U.S.*, 265 F.3d 1371, 1375, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001) (claims are not indefinite unless “insolubly ambiguous”)

The Examiner’s attention is drawn to MPEP § 2173.04, which confirms that no question of indefiniteness under § 112 ¶ 2 is stated in the Action (citations omitted):

#### **2173.04 Breadth Is Not Indefiniteness**

Breadth of a claim is not to be equated with indefiniteness. If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph.

The Examiner’s attention is also drawn to MPEP § 706.03(d), Sixth Edition in 1986, which suggested that “indirect” or “inferential” claim language, as opposed to “positively recited” claim language, might be indefinite. But that provision was removed from the MPEP over ten years ago.

The current law, as it relates to page 2 of the Office Action, is stated *Carl Zeiss Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1181, 20 USPQ2d 1094, 1100 (Fed. Cir. 1991) (underline added, citations and quotations omitted):

It has long been held, and we today reaffirm, that it is entirely consistent with the claim definiteness requirement of the second paragraph of section 112, to present “subcombination” claims, drawn to only one aspect or combination of elements of an invention that has utility separate and apart from other aspects of the invention. As one

of our predecessor courts stated, “it is not necessary that a claim recite each and every element needed for the practical utilization of the claimed subject matter,” as it is “entirely appropriate, and consistent with § 112, to present claims to only [one] aspect.” Thus, the holding of invalidity that rests on a conclusion of lack of claim definiteness is legally incorrect.

If the Examiner believes that some genuine issue of indefiniteness exists, Applicant requests that the Examiner identify a specific current document, that carries force of law, that states the law thought to apply.

## **II. Gianakouros and Hawkins**

An unnumbered paragraph of the Office Action discusses claim 13 in the context of Gianakouros ’901 and Hawkins ’146. Claim 13 recites as follows:

13. A data processing system, comprising:

a plurality of communications links designed to communicate trade information to and from a plurality of workstations, the trade information comprising information describing orders in an electronic market for items offered for sale or bid to buy, at least some of the trade information to be presented to the workstations;

a commission processing module designed to receive information relating to execution of trades in the items, and to determine a commission payable by a customer to a trade, or to apply a credit against commission fees to the customer, based at least in part on one or more characteristics from the group consisting of the time of the trade, day of the trade, location of a trade, and the customer trading location.

The English phrase “based on” in claim 13 requires some cause and effect relationship, but the Office Action is silent. The Office Action shows that a few words of the claim accidentally overlap with a few random words of the reference, but no more. The Office Action does not indicate any portion of any reference thought to correspond to a commission that is determined “based at least in part on ... the time of the trade, day of the trade, location of a trade, [or] the customer trading location.” 37 C.F.R. § 1.104(c)(2) requires that an Office Action do two things: (a) “the particular part [of a reference] relied on must be designated as nearly as practicable,” and “the pertinence ... must be clearly explained.” Instead, the Office Action designates several large “chunks” each 2/3 column long (col. 1 lines 4-43, col. 17, line 39 to col. 18 line 13), with no explanation. Because the Office Action fails to comply with either requirement of § 1.104(c)(2), no rejection exists. Further, MPEP § 707.07(f) requires an Office Action to “Answer All Material Traversed.” This same “based on” claim language has been

brought to the Examiner's attention twice before. *See, e.g.*, Paper of 9/4/2007, ¶¶ 4, 5 at pages 3-4; paper of 3/14/2007 at page 9. The failure to “answer all material traversed” is troubling.

Applicant suggests that the reason prosecution of this application has dragged on is that the Examiner has failed to “focus” on the claim language or the references. Writing out an analysis is a common sense technique for bringing focus to the examination process. It is also legally required by § 1.104(c)(2). Applicant respectfully notes that the PTO has made very clear in its recent rulemaking that waste of examination resources through lack of “focus” will not be tolerated. Applicant respectfully requests “focus” from the Examiner.

When claim language is overlooked once, it is easily excused. Twice raises questions of carelessness. When the same language is ignored a third time, after being specifically addressed twice in Applicant's prior papers, the question arises: Is the October 2007 Office Action a deliberate obstruction? Several of the patent blogs have indicated that the Office has instructed examiners to allow only some fixed maximum quota of applications, and to reject as many other applications as necessary to stay below that quota. If that is the case here, Applicant's attorney requests a phone call, so that resolution can be obtained without further inefficiency.

Applicant observes that the most relevant portion of the designated portions of the Hawkins '146 reference appears to be col. 17, lines 58-64:

Commission Basis

This field specifies the basis for the commission indicated in the commission field. One of the following codes can be selected:

P--The commission is per unit of the financial instrument.

F--The commission is a flat fee.

O--The commission is a percentage of the broker's commission.

The correspondence between this portion of Hawkins '146 and the “based on” language of the claim is not apparent without explanation.

The Office Action is too incomplete to raise any rejection. The examination of the other independent claims, 23, 25 and 37, is similarly haphazard, and insufficient to raise any rejection of these independent claims. The dependent claims are patentable with the independent claims discussed above. In addition, the dependent claims recite additional features that further distinguish the art.

### III. Conclusion

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that further extension of time is required, Applicant petitions for that extension of time required to make this reply timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. 01-1016.

Respectfully submitted,

Dated: February 15, 2008

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